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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Klaus Sommermeyer

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2584

21005

7590

10/06/2009

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EXAMINER

WHITE, EVERETT NMN

ART UNIT

PAPER NUMBER

1623

MAIL DATE

DELIVERY MODE

10/06/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/542,944	<b>Applicant(s)</b> SOMMERMEYER, KLAUS	
	<b>Examiner</b> EVERETT WHITE	<b>Art Unit</b> 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 61-79 is/are pending in the application.
- 4a) Of the above claim(s) 67-79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 61-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The amendment filed March 9, 2009 has been received, entered and carefully considered. The amendment affects the instant application accordingly:

- (A) Claims 1-60 have been previously canceled;
- (B) Comments regarding Office Action have been provided drawn to:
  - (I) traversal of the restriction requirement, which has been maintained for the reasons of record;
  - (II) objection to the specification, which has been maintained for the reasons of record;
  - (III) rejection of claims under 35 U.S.C. 112, 1<sup>st</sup> paragraph, which has been maintained for the reasons of record.

2. Claims 61-79 are pending in the case; Claims 67-79 are withdrawn from consideration.

### ***Election/Restrictions***

3. Applicant's election with traverse of Group I, newly submitted Claims 61-66 in the reply filed on July 24, 2008 is acknowledged. Applicant continues to argue against the restriction in the reply filed March 9, 2009 on the ground that there is no prior art reference on record that teaches the special technical feature of Claims 61-79, in view of the corresponding "special technical feature" being a carbonic acid diester of hydroxyethyl starch. This is not found persuasive because the claims which are drawn to the "carbonic acid diester of hydroxyethyl starch" have been deemed to be an improper introduction of new matter into the disclosure of the invention.

The requirement is still deemed proper and is therefore made FINAL.

### ***Specification***

4. The amendment filed July 24, 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The newly added term "carbonic acid diesters" disclosed throughout the specification is not supported in

the originally filed specification, therefore, introduces new matter into the disclosure of the invention.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. Applicant's arguments filed March 9, 2009 have been fully considered but they are not persuasive. Applicant argue that the term "carboxylic acid diester" recited in the original claims of the instant application was incorreccted translated from the foreign application. This argument is not persuasive since the prosecution of the instant application is based on information filed in the current originally filed application. The objection to the amended specification as introducing new matter is maintained.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 61-66 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Added Claims 61-66 are drawn to an aprotic-solvent-soluble carbonic diester of hydroxyethyl starch, which does not conformed to the requirement of the first paragraph of 35 U.S.C. 112 since the originally filed specification does not support the term "carbonic diester" or "carbonic diester of hydroxyethyl starch". The added terms "carbonic diester" and "carbonic diester of hydroxyethyl starch" into the claims are viewed as improper introduction of new matter into the claims of the invention.

7. Applicant's arguments filed March 9, 2009 have been fully considered but they are not persuasive. Applicant argue that the term "carboxylic acid diester" recited in the original claims of the instant application was incorreccted translated from the foreign application. This argument is not persuasive since the prosecution of the instant

application is based on information filed in the current originally filed application. The rejection of Claims 61-66 under 35 U.S.C. 112, first paragraph, as introducing new matter is maintained.

***Reply to Final Must Include Cancellation of Claims Non-elected with Traverse***

8. This application contains Claims 67-79 drawn to an invention nonelected with traverse in the reply filed on July 24, 2008. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Summary***

9. The specification is objected to; Claims 61-66 have been rejected; Claims 67-79 are withdrawn from consideration as being directed to non-elected inventions.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Examiner's Telephone Number, Fax Number, and Other Information***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is 571-272-0660. The examiner can normally be reached on 9:30 to 6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Everett White/

Examiner, Art Unit 1623

/Shaojia Anna Jiang/

Supervisory Patent Examiner, Art Unit 1623